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OFFICE OF PETITIONS

In re Patent No. 7,137,322 : DECISION ON REQUEST FOR
Mark et al. : RECONSIDERATION OF
Issue Date: November 21, 2006 : PATENT TERM ADJUSTMENT
Application No. 09/824,838 : AND NOTICE OF INTENT TO ISSUE
Filed: April 4, 2001 : CERTIFICATE OF CORRECTION
Attorney Docket No. 8932-392 :

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT" filed January 22, 2007. Patentee requests that the patent term adjustment indicated on the above-identified patent be corrected from zero (0) days to two hundred fifty-five (255) days.

The application for patent term adjustment is **GRANTED** to the extent indicated herein.

Patentee is given **TWO (2) MONTHS** from the mail date of this decision to respond. No extensions of time will be granted under 37 CFR 1.136.

The patent term adjustment indicated on the patent is to be corrected by issuance of a certificate of correction showing a revised patent term adjustment of **thirty-seven (37) days**.

Preliminarily, patentee is reminded that 35 U.S.C. 154(b) provides for patent term adjustment for examination delay. Pursuant to 35 U.S.C. 154(b)(3)(B) and implementing regulation 37 CFR 1.705, an applicant shall receive an initial determination of patent term adjustment with the mailing of the Notice of Allowance and shall

be given one opportunity to request reconsideration of that determination by way of filing of an application for patent term adjustment (and fee for application for patent term adjustment) prior to the payment of the issue fee. Thus, any application for patent term adjustment disputing the initial determination of patent term adjustment at the time of the mailing of the Notice of Allowance filed after payment of the issue fee may be dismissed as untimely filed.

However, in this instance, on May 31, 2006, the Office mailed the initial determination of patent term adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date was 0 days. On August 28, 2006, patentee paid the issue fee. At the time of the mailing of the notice of allowance, there was no dispute as to the accuracy of this determination because as of the mailing of the notice of allowance, the undisputed periods of reduction for applicant delay exceeded the period of adjustment for Office delay. As the Office does not set forth negative balances of patent term adjustment, the initial determination of patent term adjustment of 0 days was properly not disputed.

However, upon issuance of the patent, a period of adjustment of 348 days pursuant to 37 CFR 1.702(b) was entered for the Office taking in excess of three years to issue the patent. In view thereof, the entry of the periods of reduction for applicant delay before the mailing of the notice of allowance became an issue. Under the circumstances, the application for patent term adjustment will not be dismissed as untimely filed, but will be considered on the merits.

With respect to the merits, patentee disputes the periods of reduction of 55 days, 299 days, and 164 days pursuant to 37 CFR 1.704(b).¹ Additionally, patentee asserts that the correct period of adjustment under 37 CFR 1.702(b) is 347 days, not 348 days.

The application history has been reviewed and it has been determined that the patent term adjustment indicated in the patent is incorrect.

¹ Patentee does not disagree with the reduction under 37 CFR 1.704(b) of 92 days for responding in excess of three months from the December 11, 2001 mail date of the nonfinal Office action.

As to the reduction of 55 days, the Office concludes that patentee was properly assessed a delay under 37 CFR 1.704(b). The record reveals that patentee filed a reply in compliance with 37 CFR 1.113(c) on February 4, 2003, in excess of the three-month period from the September 11, 2002 mailing date of the final Office action. Thus, patentee failed to engage in reasonable efforts to conclude prosecution of this application. Accordingly, the period of adjustment was properly reduced by 55 days, the number of days in the period beginning on the day after the date that is three months after the date of mailing of the final Office action, December 12, 2002, ending on the date the reply in compliance with § 1.113(c) was filed, February 4, 2003. See 37 CFR 1.704(b). Accordingly, the reduction of 55 days is warranted and will not be removed.

As to the reduction of 299 days, the application file confirms that a reply was filed on July 30, 2003. On May 11, 2004, patentee submitted a copy of the response accompanied by a copy of their itemized return postcard, associated with the filing of the response, with a USPTO date-stamp of July 30, 2003. The date-stamped and itemized postcard receipt serves as *prima facie* evidence that the original reply was received by the Office on July 30, 2003. See MPEP 503. Under these circumstances, the date of receipt of the response on July 30, 2003, should be properly used for purposes of calculating compliance with 37 CFR 1.704(b). The response was filed within the three-month of the May 12, 2003 mailing date of the nonfinal Office action. See 37 CFR 1.704(b). Patentee did not fail to engage in reasonable efforts to conclude processing by delaying in responding to the nonfinal Office action. Accordingly, the period of reduction of 299 days is not warranted and will be removed.

Patentee also disputes the reduction of 164 days pursuant to 37 CFR 1.704(c)(7). The record reveals that patentee filed a non-compliant amendment on May 11, 2004. In response, the Office mailed a Notice of Non-Compliant Amendment (37 CFR § 1.121) on September 22, 2004. On October 22, 2004, patentee filed an amendment correcting the omission. The submission of a non-compliant amendment is a proper basis for reduction of patent term under 37 CFR 1.704(c)(7). Accordingly, the period of adjustment of the term of the patent was properly reduced by 164 days, the number of days beginning on the day after the date the non-compliant amendment was filed, May 12, 2004, and ending on the date that the amendment correcting the omission was filed, October

22, 2004. Thus, the reduction of 164 days for the submission of a reply having an omission is warranted and will not be removed.

Patentee asserts that the period of adjustment under 37 CFR 1.702(b) is 347 days, not 348 days as indicated in the PTA Calculations. Pursuant to 35 U.S.C. 154(B) (1), § 1.703(b) (1) provides, in pertinent part that:

the period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) ... and ending on the date a patent was issued, but not including the sum of the following periods:

- (1) The number of days, if any, in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued;

The filing of a RCE cuts-off an applicant's ability to accumulate any additional patent term adjustment against the three-year pendency provision, but does not otherwise affect patent term adjustment. Therefore, the period under 37 CFR 1.703(b) is counted beginning on the day after the date that is three years after the date on which the application was filed and ending on the day the RCE was filed. "When a period is indicated (in 37 CFR 1.703 or 1.704) as 'beginning' on a particular day, that day is included in the period, in that such day is 'day one' of the period and not 'day zero.'" MPEP 2731. "For example, a period beginning on April 1 and ending on April 10 is ten (and not nine) days in length."

Id.

In this instance, patentee filed a RCE on March 18, 2005. Thus, the period of adjustment under 37 CFR 1.702(b) was correctly calculated as 348 days, counting the number of days beginning on the day after the date that is three years after the date on which the application was filed, April 5, 2004, and ending on the day the RCE was filed, March 18, 2005. See 37 CFR 1.703(b) (1).

Further, a period of adjustment of 297 days is acknowledged for the Office's failure to respond to a reply within four months after the date on which the reply was filed pursuant to 37 CFR

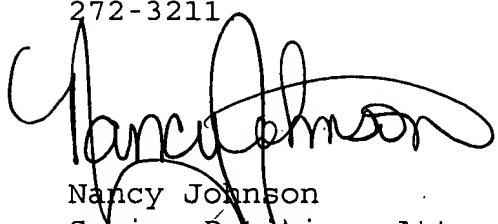
1.702(a)(2). As indicated above, patentee filed a reply on July 30, 2003. Patentee asserts that the Office did not respond to the reply until the mailing of the final Office action on December 21, 2004. The record reveals that the Office responded to the reply with the mailing of the Notice of Non-Compliant Amendment (37 CFR § 1.121) on September 22, 2004, four months and 297 days after the filing of the reply. See 37 CFR 1.703(a)(2). However, any days of delay for Office issuance of the patent more than three years after the filing date of the application, which overlap, with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. Further, in considering the overlap, the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). See 35 U.S.C. 154(b)(1)(B); 35 U.S.C. 154(b)(2)(A); and 37 CFR 1.703(f). In this instance, the period of adjustment of 348 days attributable to the delay in the issuance of the patent overlaps with the period of adjustment of 297 days attributable to grounds specified in 37 CFR 1.702(a)(2). Thus, no additional period of adjustment under 37 CFR 1.702(b) will be entered beyond the 348 days.

In view thereof, the patent should have issued with a revised patent term adjustment of **thirty-seven (37) days** (348 days of Office delay reduced by 311 days (92 + 55 + 164) of applicant delay).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by thirty-seven (37) days.

Telephone inquiries specific to this matter should be directed to
Christina Tartera Donnell, Senior Petitions Attorney, at (571)
272-3211


Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,137,322 B2
DATED : Nov. 21, 2006
INVENTOR(S) : Mark et al.

DRAFT

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (0) days

Delete the phrase "by 0 days" and insert -- by 37 days--